



Docket No.: 070456-0025

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 20277
Chikara OHKI, et al.	:	Confirmation Number: Not Yet Assigned
Application No.: 10/809,797	:	Group Art Unit: 3682
Filed: March 26, 2004	:	Examiner: Marcus CHARLES
For: COMPRESSOR BEARING AND COMPRESSOR COMPONENT	:	

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Office Action dated May 25, 2007, having a three-month shortened statutory period for response set to expire August 25, 2007.

Claims 1-24 are pending in this application.

In the Office Action, claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 4,867,649 (Kawashima) in view of US Publication 2003/0123769 (Ohki). This rejection is respectfully traversed. Applicants hereby request reconsideration and allowance of the claims in view of the following arguments.

Regarding the rejection of independent claims 1-4, 11, and 18, it is admitted in the Office Action that the primary Kawashima reference does not teach or suggest the austenite grain size number required by claims 1 and 4, the fracture stress value required by claims 2 and 11, or the hydrogen content required by claims 3 and 18. It is further contended that the Ohki reference

furnishes these claimed features, and it would have been obvious to combine Kawashima and Ohki to yield the claimed invention. However, under 35 U.S.C. §103(c), Ohki cannot be cited as prior art against the present application.

According to §103(c)(1), “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” In the present case, the subject matter of Ohki and the subject matter of the invention claimed in claims 1-24 of the present application were commonly owned (by NTN Corporation) at the time of the invention of the claimed subject matter.

Moreover, Ohki qualifies as prior art only under 35 U.S.C. §102(e), which states that a person shall be entitled to a patent unless “the invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” The earliest effective date of invention of the subject matter of the present application is the Japanese priority date, March 28, 2003, while Ohki’s U.S. filing date was November 21, 2002. Thus, Ohki qualifies as prior art under §102(e). However, since Ohki was published on July 3, 2003, which is after the priority date of the present application, it does not qualify as prior art under any other subsection of §102.

Submitted herewith is a certified English-language translation of the Japanese priority document, Japanese Application 2003-091300. With this submission, Ohki is eliminated as a reference against the present application. The obviousness rejection based on Kawashima and Ohki should consequently be withdrawn because, as discussed hereinabove, Kawashima does not

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teach or suggest the austenite grain size number required by independent claims 1 and 4, the fracture stress value required by independent claims 2 and 11, or the hydrogen content required by independent claims 3 and 18. Thus, Kawashima cannot by itself render the claims obvious, and it would not have been obvious to add the above-discussed features of the independent claims to Kawashima's refrigerating system to yield the claimed invention.

Consequently, independent claims 1-4, 11, and 18 are patentable, as are claims 5-10, 12-17, and 19-24, which depend from claims 4, 11, and 18, respectively.

Accordingly, the application is now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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